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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,658	12/31/2003	Jacob Mathiesen	GTI-5001-CP	2809
89065	7590	01/27/2010		
VGX Pharmaceuticals LLC	EXAMINER			
450 Sentry Parkway	GRAY, PHILLIP A			
Blue Bell, PA 19422			ART UNIT	PAPER NUMBER
			3767	
NOTIFICATION DATE	DELIVERY MODE			
01/27/2010	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

US.Patents@inovio.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,658	<b>Applicant(s)</b> MATHIESEN ET AL.
	<b>Examiner</b> Philip Gray	<b>Art Unit</b> 3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 October 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to applicants communication of 10/2/2009.

Currently claims 1-17 are pending and rejected below.

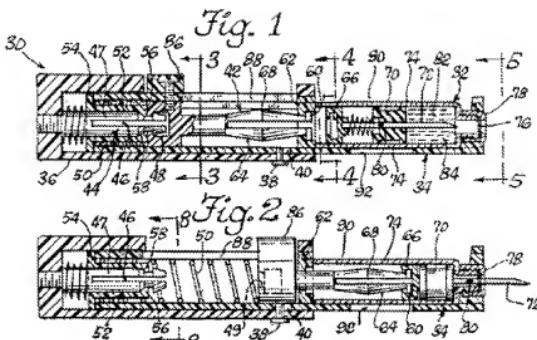
#### ***Claim Rejections - 35 USC § 102 (2<sup>nd</sup> time)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 16-11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by SCHMITZ (U.S. Patent 5,620,421). Schmitz discloses a syringe injector system with a hollow needle (72), a fluid delivery means (70~66), needle insertion means for guiding insertion of the needle (78), a base (48~49~68), housing (90), piston driving means (66), control mechanism (46), and motor (50) for the piston driving means. Note figures 1 and 2 below.



***Claim Rejections - 35 USC § 103 (2<sup>nd</sup> time)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4, 6-7, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHMITZ in view of DALAMAGAS et al. (U.S. Patent 5,271,413).

Schmitz discloses the claimed invention except for the method and sensors to sense the tissue for injection from a hypodermic needle. This includes the sensors which sense a depth for tissue penetration and injection comprising an bio impedance, resistance or ultrasound probing sensors and then actuating the piston (see abstract and note voltage is applied to needle to measure bioimpedance). DALAMAGAS teaches that it is known to use the method and sensors to sense the tissue for injection from a hypodermic needle (sensors which sense a depth for tissue penetration and injection comprising an bio impedance, resistance or ultrasound probing sensors and then actuating the piston) as set forth in paragraphs at column 1 line 55 through column 2 line 26 to provide a means for reliably injecting pharmaceuticals into the intended tissue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by SCHMITZ with sensors which sense a depth for tissue penetration as taught by DALAMAGAS, since such a modification would provide the system with sensors which sense a depth for tissue penetration for providing a means for reliably injecting pharmaceuticals into the intended tissue.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHMITZ in view of KLEIN et al. (U.S. Patent 4,877,134). SCHMITZ discloses the

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claimed invention except for the barcode identification recording and data system. BUHLER teaches that it is known to use a barcode identification and data recording as set forth in paragraphs at column 5 lines 40-55 to provide an identity of the sample associated with the particular test tube (vessel). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by SCHMITZ with a barcode identification and data recording as taught by BUHLER, since such a modification would provide the system with a barcode identification and data recording for providing an identity of the sample associated with the particular test tube.

***Response to Arguments***

Applicant's arguments filed 10/2/2009 have been fully considered but they are not persuasive. Applicant's argue that the prior art of record fails to disclose an apparatus that concurrently injects fluid during insertion of the needle into the body tissue.

In response to applicant's argument that the prior art of record fails to disclose concurrent injection of fluid during insertion, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is examiners position that the Schmitz apparatus would be capable of concurrent injection [see abstract[

In response to applicant's arguments, the recitation of concurrently injecting the fluid during injection of the needle has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The elements disclosed in the prior art of record (Schmitz for example) are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made and proper. See rejection discussion below.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571)272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Phillip Gray/  
Examiner, Art Unit 3767

/Kevin C. Sirmons/  
Supervisory Patent Examiner, Art Unit 3767